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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/331,959	09/28/1999	RAYMOND DUBOUIS	022701-831	2312

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EXAMINER
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MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 01/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

T.D-21

# Advisory Action

Application No.  
09/331,959

Applicant(s)  
Dubouis et al.

Examiner  
Margaret Moore

Art Unit  
1712



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Dec 18, 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on Dec 18, 2001. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☐ they raise the issue of new matter. (See NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE:

4. ☒ Applicant's reply has overcome the following rejection(s):  
The rejection of claim 14.
5. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
\_\_\_\_\_
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):  
Claim(s) allowed: None  
Claim(s) objected to: None  
Claim(s) rejected: 1-21
9. ☐ The proposed drawing correction filed on \_\_\_\_\_ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
11. ☒ Other: see attached paper.

MARGARET MOORE  
PRIMARY EXAMINER  
ART UNIT 1712

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Attachment to paper # 21

With regards to claim 15, while the rejection was not misplaced, the Examiner agrees that it could have been made clearer. The phrase "antecedent basis" was intended to refer to the fact that the polyorganosiloxane composition D in claim 1 comprises an alkenylsilyl group carrying constituent and a *hydrosilyl* group carrying constituent, while claim 15 refers to an alkenylsilyl group carrying constituent and *hydroalkenyl* group carrying constituent. The composition D in claim 1 does not include a hydroalkenyl group carrying constituent. In fact, "hydroalkenyl" does not even appear to be a technically accurate term.

With regards to the rejection over Takita et al., the Examiner notes that applicants do not provide any further arguments and as such the rejection is maintained for reasons of record.

With regards to the rejection over JP '644 in view of Matsushita, the Examiner notes that this again does not address the obviousness issue at hand, i.e. the obviousness of one silicone forming composition in view of the other. With regards to the arguments that are provided, these are not persuasive of the unobviousness of the totality of the composition. A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments.

"A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) In this instance, the invention was directed to a an epoxy impregnated fiber-reinforced printed circuit material. The applied prior art reference taught a printed circuit material similar to that of the claims but impregnated with polyester-imide resin instead of epoxy. The reference, however, disclosed that epoxy was known for this use, but that epoxy impregnated circuit boards have "relatively acceptable dimensional stability" and "some degree of flexibility," but are inferior to circuit boards impregnated with polyester-imide resins. The court upheld the rejection concluding that, while the reference did teach away from

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using epoxy, the "teaching away" was insufficient to overcome the rejection since "Gurley asserted no discovery beyond what was known in the art." 27 F.3d at 554, 31 USPQ2d at 1132.).

This is similar to the instant situation in which one iron oxide/Pt composition is preferred over another. As is shown in by the prior art, the iron oxide/Pt components in '644 may have some disadvantages, but they are operable. Thus this perceived teaching away is not sufficient to render the claims unobvious, since the skilled artisan would have had a reasonable expectation of success in using the iron oxide/Pt combination disclosed by '644. Applicants have made no discovery beyond what was known in the art and the use of a known iron oxide/ Pt combination over what could be considered a more advantageous combination would have been obvious to the skilled artisan.

MARGARET G. MOORE  
Principal Examiner  
Art Unit 1712